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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/697,350

10/30/2003

Dyson W. Hickingbotham

2528US

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12/27/2007

ALCON

IP LEGAL, TB4-8

6201 SOUTH FREEWAY

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EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3735

MAIL DATE

DELIVERY MODE

12/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/697,350	<b>Applicant(s)</b> HICKINGBOTHAM, DYSON W.	
	<b>Examiner</b> david shay	<b>Art Unit</b> 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on October 10, 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The drawing objection is moot in view of the drawings filed October 7, 2005.

It is noted that claims 11 and 30 contain a means plus function recitation.

Applicant argues that “Turner alone, as stated by the Examiner, does not teach or suggest a hemispherical lens element, nor does Turner teach that the lens provides little refraction when immersed in the vitreous.” The examiner the examiner must respectfully point out that, it is not Turner “alone” which provides these teachings, but the teachings of Turner in combination with the knowledge of one of ordinary skill in the art. Turner does emphasize that the “light bending surface” is the curved surface of the lens which is in contact with the air gap (see for example column 2, lines 8-12), and also specifically states that introducing vitreous into the air gap would affect “the light bending which results” (see column 2, line 14). One having ordinary skill in the art of ophthalmic endoilluminators would be thoroughly familiar with the effects of optical index differences at optical boundaries, that they relate not only to the difference of the indecies involved, but also the shape of the interface involved, and also the refractive index of tissues of the eye involved, e.g. the vitreous. Given the teachings of Turner, combined with the knowledge of one of ordinary skill in the art, it would be clear that if a larger angle of divergence of the light emitted by the endoilluminators was desired, that the curvature of the output face could be reduced to provide this effect. As such, this modification merely represents a difference in degree, rather than kind, and would have been obvious to one of ordinary skill in the art.

Claims 1-7, 9-11, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner in combination with Grinblat et al. Turner teaches a wide-angle endoilluminator as

claimed, except the lens being hemispherical. Grinblat et al teach an illuminator for retinal surgery wherein the optical fiber is able to be advanced or retracted. It would have been obvious to the artisan or ordinary skill to employ a linearly translatable fiber in the device of Turner, since this allows the illumination of different areas, and to employ a xenon light source, since these are equivalents, as taught by Grinblat et al, or to employ the lens fiber arrangement of Turner in the device of Grinblat et al, since this provides beam spreading which is superior to that of refractive surfaces directly on the end of optical fibers, as taught by Turner, and in either case to provide the precise probe diameters claimed, since this is not critical; is well within the skill of one having ordinary skill in the art; and provides no unexpected result; to employ a hemispherical, rather than a ball lens, since the distalmost surface of the lens provides little refraction when immersed in the vitreous, as taught by Turner; to employ a multifiber cable and a cable which is of the same gauge as the optical fiber, since this would provide a more flexible cable due to the use of smaller individual fibers and more efficient light transfer due to the transmitting and receiving faces having the same surface area and to provide the optical element with the same gauge as the fiber for the same reason and to provide a cable which is integral with the fiber, since this would provide the most efficient light transport, thus producing a device such as claimed.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Turner in combination with Grinblat et al as applied to claims 1-7, 9-11, and 14-18 above, and further in combination with Shen et al. Shen et al teach that SMA connectors are standard. It would have been obvious to the artisan of ordinary skill to provide SMA connectors on the optical fiber and cable, since these are standard, as taught by Shen et al, thus producing a device such as claimed.

Applicant's arguments filed October 10, 2007 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

Art Unit: 3735

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/

Primary Examiner, Art Unit 3735